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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE V. GUYAN and ROBERT H. PISH

Appeal 2008-005998
Application 09/305,146
Technology Center 2100

Decided:¹ June 9, 2009

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Data (electronic delivery).

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 22, 41-65, and 67. Claims 1-21 and 23-40 have been cancelled. Claim 66 has been allowed (Ans. 9, para. 1). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellants' invention relates generally to information management. More particularly, Appellants' invention relates to linking information during insurance claim processing utilizing a computer system. (Spec. 1).

Claims 22 and 67 are illustrative:

22. A system for displaying information about an insurance claim for an insured event, the system comprising:

a server component including an event processor and a task engine application program that interacts with the event processor to enable said insurance claim to be processed; and

a data component residing on the server component, the data component comprising a claim folder that decomposes a claim related to the insured event into a plurality of levels, the plurality of levels including a policy level, a claim level, a participant level and a line level, wherein the server component is configured to generate a user interactive interface that interactively displays at least one of the plurality of levels reflecting information related to a policy, the claim, claimants and an insured person in a structured format to a plurality of users, and to allow each of the users to simultaneously interact with one of the plurality of levels to retrieve and enter data for the same insurance claim;

wherein the event processor maintains clear encapsulation of responsibilities of said system for displaying information from said event processor, *wherein said responsibilities do not include functions performed by said event processor*, interacts with the data component to identify a data event that affects data in the claim folder, determines a response, identifies a system component to enable said claim to be processed and transmits the data event to the identified system component;

wherein when said identified system component is the task engine, the task engine evaluates the data event, determines claim characteristics and matches the characteristics to tasks to automatically generate a list of tasks to be taken by one of the plurality of users handling said insurance claim to direct a workflow for said insurance claim to be processed.

(emphasis added).

67. A system that displays insurance claim information comprising:

a data component that includes a claim folder that decomposes a claim related to an insured event into a plurality of levels, the plurality of levels include a policy level, a claim level, a participant level and a line level;

a user interactive interface that is generated and interactively displays information from at least one of the plurality of levels in a structured format to a plurality of users, wherein *a plurality of users via a plurality of interfaces is allowed to simultaneously interact with one of the plurality of levels to retrieve and enter data on the same insurance claim*; and

an event processor that identifies the entered data as a data event, determines a response for the data event and identifies a system component to process the response and transmits information for processing the claim to the identified system component.

(emphasis added).

PRIOR ART

The Examiner relies upon the following reference as evidence in support of the anticipation rejection:

Borghesi	US 5,950,169	Sep. 7, 1999
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THE REJECTIONS

1. The Examiner rejected claims 22 and 41-65 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. The Examiner rejected claim 67 under 35 U.S.C. § 102(e) as being anticipated by Borghesi.

APPELLANTS' CONTENTIONS

Regarding the Examiner's rejection of claim 22 under § 112, first paragraph, Appellants contend that the negative claim limitation *wherein said responsibilities do not include functions performed by said event processor* is fully supported at pages 2 and 185 of the original Specification (App. Br. 14-15).

Regarding the Examiner's rejection of claim 67 for anticipation, Appellants contend that Borghesi does not disclose the recited limitation of

a plurality of users via a plurality of interfaces is allowed to simultaneously interact with one of the plurality of levels to retrieve and enter data on the same insurance claim (App. Br. 20).

EXAMINER'S FINDINGS

Regarding the rejection under 35 U.S.C. § 112, first paragraph, the Examiner maintains there is no support found in the Specification for the claimed negative limitation that the Examiner considers to be new matter added by amendment. (Ans. 5-8). Regarding the anticipation rejection of independent claim 67, the Examiner maintains that the limitations argued by Appellants are disclosed by Borghesi (Ans. 9-10).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Have Appellants shown the Examiner erred in finding that the negative claim limitation *wherein said responsibilities do not include functions performed by said event processor* is not supported in the original Specification such that the Specification conveys with reasonable clarity to those skilled in the art that Appellants were in possession of the invention at the time of filing? (*See claim 22*).
2. Have Appellants shown the Examiner erred in finding that Borghesi discloses the recited limitation of *a plurality of users via a plurality of interfaces is allowed to simultaneously interact with one of the*

plurality of levels to retrieve and enter data on the same insurance claim? (See claim 67).

PRINCIPLES OF LAW

35 U.S.C. § 112

Section 112 of Title 35 provides, in relevant part, that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112, first paragraph (emphasis added).

As recently reaffirmed by the Federal Circuit:

“To satisfy the written description requirement, ‘the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’” *Carnegie Mellon Univ. v. Hoffmann La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996)). “In other words, the applicant must ‘convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,’ and demonstrate that by disclosure in the specification of the patent.” *Id.* (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)). Such disclosure need not recite the claimed invention *in haec verba*, but it must do more than merely disclose that which would render the claimed invention obvious. [*Univ. of Rochester v. G.D. Searle & Co.*], 358 F.3d [916] at 923 [(Fed. Cir. 2004)];

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Regents of the Univ. of Cal. v. Eli Lilly & Co., 119 F.3d 1559, 1566–67 (Fed. Cir. 1997); *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306–07 (Fed. Cir. 2008) (explaining that § 112, ¶1 “requires that the written description actually or inherently disclose the claim element”).

Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 560 F.3d 1366, 1371-72 (Fed. Cir. 2009).

Anticipation under 35 U.S.C. § 102

A party asserting that a patent claim is anticipated under 35 U.S.C. § 102 must demonstrate, among other things, identity of invention . . . [which] is a question of fact . . . one who seeks such a finding must show that each element of the claim in issue is found, either expressly described or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.

Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984) (citation omitted), *overruled on other gds.*, *SRI Intern'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1125 (Fed. Cir. 1985).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants’ Briefs to show error in the proffered prima facie case.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by a preponderance of the evidence:

APPELLANTS' SPECIFICATION

1. Appellants' Specification discloses:

Component Functionality

As shown in Figure 14, the Event Processor 1400 utilizes a common queue 208 of events 1006 that are populated by any component 1402 of the system to identify what events have occurred. Working this queue, the Event Processor determines the appropriate response for an event and provides information to other components that need to process them. The Event Processor does not process any events itself and maintains clear encapsulation of system responsibilities. For example, an event that affects claim data is processed by the claim component.

(Spec. 185, ll. 8-16).

THE BORGHESI REFERENCE

2. Borghesi discloses:

Each remote computer, whether a single user computer or a computer in a local area network, provides an interface for a user to access the assigned or pertinent claim workfile. The user interface not only comprises a video display of monitor, but also includes a universal display screen. The universal display screen, preferably a graphic user interface, displays at least one workfile/datafile in addition to visual objects representative of actions to be taken on a workfile. In a preferred embodiment where the universal entry screen is the graphic user interface described above, an opened insurance claim datafile has a plurality of tabbed sections, each tabbed section representing a separate view of the datafile. A user may access each of the tabs by using a keyboard or other user input means.

(Col. 7, ll. 40-53 *see also* Fig. 5).

ANALYSIS

ISSUE 1

We decide the question of whether Appellants have shown the Examiner erred in finding that the negative claim limitation *wherein said responsibilities do not include functions performed by said event processor* is not supported in the original Specification. (See claim 22).

“[T]he purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.’” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920 (Fed. Cir. 2004) (quoting *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000)).

Regarding negative limitations, our reviewing court has determined that an express intent to confer on the claim language the novel meaning imparted by the negative limitation is required, such as an express disclaimer or independent lexicography in the written description that provides support for the negative limitation. *Omega Engineering, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (citations omitted).

For convenience, the disputed negative limitation is shown in context in italics:

wherein the event processor maintains clear encapsulation of responsibilities of said system for displaying information from said event processor, *wherein said responsibilities do not include functions performed by said event processor*, interacts with the data component to identify a data event that affects data in the claim folder, determines a response, identifies a system component to enable said claim to be

processed and transmits the data event to the identified system component[.]

(Claim 22).

Based upon our review of Appellants' original disclosure, we agree with the Examiner that page 2 of the Specification does not provide the proffered support for the negative claim limitation of *wherein said [system] responsibilities do not include functions performed by said event processor*. (Claim 22).

However, we find the Specification at page 185 conveys with reasonable clarity to those skilled in the art that Appellants were in possession of the invention at the time of filing, as reproduced in pertinent part: "Working this queue, the Event Processor determines the appropriate response for an event and provides information to other components that need to process them. The Event Processor does not process any events itself and maintains clear encapsulation of system responsibilities." (FF 1, emphasis and underlining added).

Because we find Appellants have shown the Examiner erred, we reverse the Examiner's rejection of claims 22 and 41-65 under 35 U.S.C. § 112, first paragraph.

ISSUE 2

We decide the question of whether Appellants have shown the Examiner erred in finding Borghesi discloses the recited limitation of *a plurality of users via a plurality of interfaces is allowed to simultaneously interact with one of the plurality of levels to retrieve and enter data on the same insurance claim*. (See claim 67).

The Examiner finds the aforementioned limitation is disclosed at column 7, lines 40-42 of Borghesi (Ans. 9). The Examiner finds this portion of Borghesi describes

a local area network in which each computer within the local area network has an interface to access a claim file and all of its tabbed sections. By such an arrangement, simultaneous user interaction can occur with the claim file. There is no factual basis to assuming that only one user can access a claim file if all the users have an interface which can achieve such access. Additionally, the usage of a file server (col. 7, line 6) inherently permits simultaneous access to the claim files. Furthermore, there is no suggestion in Borghesi that all other users are “locked out” when one single user accesses the system.

(Ans. 9) (underlining omitted).

Thus, the Examiner has determined that simultaneous user interaction *can* occur with Borghesi’s claim file, and that the usage of a file server (col. 7, line 6) *inherently* permits simultaneous access to the claim files. (Ans. 9).

We agree with the Examiner that Borghesi describes a networked computer system that appears to provide for at least simultaneous read access to the insurance claim files (FF 2; *see also* Fig. 5). However, we note that the claim requires *simultaneous interaction with one of the plurality of levels between a plurality of users that are allowed to retrieve and enter data on the same insurance claim.* (See claim 67).

We find that the Examiner, as finder of fact, has not fully developed the record so as to clearly show exactly where the disputed limitations are taught within the Borghesi reference. Based upon our independent review of Borghesi, we find no specific disclosure regarding simultaneous read and

write access on the same insurance claim between a plurality of interacting users. We note that the problems associated with simultaneous write access to shared data (or shared resources) are well known in the art of data processing. However, we find the Borghesi reference is silent regarding a specific disclosure of locks, semaphores, or other shared data access control mechanisms that would enable (essentially) simultaneous entry of data between multiple users of the same insurance claim file. Thus, to affirm the Examiner on this record would require speculation on our part. While the Examiner has proffered that simultaneous user interaction can occur with Borghesi's claim file (Ans. 9), we note that our reviewing court has clearly stated that "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999).

Therefore, Appellants have shown the Examiner erred in finding that Borghesi discloses the recited limitation of *a plurality of users via a plurality of interfaces is allowed to simultaneously interact with one of the plurality of levels to retrieve and enter data on the same insurance claim* (see claim 67). "Absence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). Accordingly, we reverse the Examiner rejection of independent claim 67 as being anticipated by Borghesi.

CONCLUSION

Based on the findings of facts and analysis above, Appellants have established that the Examiner erred in rejecting claims 22 and 41-65 under

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35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Based on the findings of facts and analysis above, Appellants have established that the Examiner erred in rejecting claim 67 under 35 U.S.C. § 102(e) as being anticipated by Borghesi.

DECISION

The Examiner's decision rejecting claims 22, 41-65, and 67 is reversed.

REVERSED

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